



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

5 **Kim Marie Clark**

Filed: **August 5, 2003**

10 Serial No. **10/634,204**

For: **ADHESIVE CORD COVER**

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Art Unit: **3765**

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Examiner: **Ahmad, Nasser**

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Attorney Docket No.: **317270.4/A02201US**

AMENDMENT

15 Commissioner of Patents
Mail Stop: Amendment
P.O. Box 1450
Alexandria, Virginia 22313-1450

20 Dear Sir:

Applicant acknowledges receipt of the Office Action issued in the above identified application on February 3, 2005, and the Notice of Non-Compliant Amendment. Applicant refiles the amendment previously filed, however with the claims beginning on a separate page. Applicant regrets any inconvenience in its oversight. Applicant appreciates the thorough review of the subject of the invention and the assessment of the prior art in the rejection of claims 1 through 10.

The Rejections

30 Claims 1 and 5 - 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ratzlaff (5,099,889), and under 35 U.S.C. 103(a) as being obvious based upon Padilla (5,869,159) in view of Petock.

35 Claims 1 -3 and 5 - 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzlaff

in view of Simmons (5,964,252)

Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzlaff in view of Tomberlin (4,939,778).

In respect to the rejection of claims 1 and 5 - 7 under 35 U.S.C. 102(b) it is well known that to anticipate a claim, the reference must teach every element of the claim. MPEP §2131. Further, 5 the identical invention must be shown - in as complete detail as in the claim. *Richardson v. Suzuki Motor Co.* 9 USPQ2d 1913, 1920 (Fed.Cir. 1989). Careful review of Ratzlaff reveals that, while being a cover, in that it is a protective layer of shock absorbing material, it can hardly be said to be decorative (as the claim is now amended) nor can it be described as being constructed of a fabric. It is described as a mat of open weave construction. A further element of Applicant's independent 10 claims 1 and 5 are that the pressure sensitive adhesive adhered to the strip be selectively adhered to the fabric. The cover of Ratzlaff is described as a protective covering for pipe to be laid in a trench and thus, not selectively adhered as for selective removal.

In respect of the rejections under 35 U.S.C. 103(a), it is recognized that one cannot show non-obviousness by attacking references individually where the rejection is based on a combination of 15 references, *In re Keller*, 642 F,2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co., Inc.*, the teachings in the individual references must, nevertheless, be considered when analyzing whether one of ordinary skill in the art would have considered combining such teachings and whether the hypothetical structure that would have resulted from the combined teachings would have included all 20 of the claimed features. for these reasons, the individual references applied in the rejections are first discussed separately below to allow for a complete understanding of what the references would have suggested to one of ordinary skill in the art and to establish a basis for Applicant's position that one of ordinary skill in the art would not have considered combining the reference teachings in the manner contemplated by the Examiner.

Patent 5,099,889 to Ratzlaff discloses an external pipe protector for protecting pipe which is 25 laid underground. The protector includes a flexible (so that it may be wrapped around the rigid pipe) of shock absorbing material. The material is of open weave to enable a charged electrical rod to penetrate the open weave for crack and rust deposit testing of the steel pipe.

Patent 5,869,159 to Padilla is directed to a method and a kit for cushioning and covering such as a lally column of the type supporting joists in buildings. Lally columns are usually cylindrical steel poles, having a height of 7 to 8 feet and diameters of 2 to 12 inches. The kit is composed of a pair of "wraps", the first being something in the nature of "bubble wrap" and the second wrap is 5 preferably a polyvinyl chloride sheet. There is no suggestion in the disclosure of selective removal of the covering.

Petock (3,884,495) is directed to a child's walker, i.e., a retaining seat or wheels that may be used by a child as when learning to walk and moving the walker around ones house. It is common for such vehicles to be operated indiscriminately by the child, at least with respect to furniture, walls 10 and other household articles. The disclosure is of a walker having a resilient material wrapped around the tubular legs or support members which support the seat of the walker on wheels or casters. The resilient material is suggested to be attached in a number of ways as by being formed in a tubular shape and slid over the legs, or permanently installed as by being adhesively applied directly to the legs. The preferred embodiment illustrated is provided with straps and snaps to wrap 15 around the material and hold it on.

Simmons(5,964,252) relates to a closure system, either temporary or permanent for pipe insulation sleeves. The insulation wrap is fitted with a closure wrap along one longitudinal edge and has applied thereto a strip of adhesive. The wrap includes a non-stick strip over the adhesive layer, having intermittent holes or openings through which the adhesive is accessible, such that for a 20 temporary installation, the closure wrap may be removeably attached to the insulation. For permanent installation, the non-stick layer is removed to expose the full adhesive to the insulation.

Tomberlin (4,939,778) is directed to a protective telephone cord cover to prevent the cord from becoming entangled. In an alternative embodiment, the cover is shown as having hook and loop material sewn along the edges for enabling the installation of the cover around a cord of an 25 older telephone which has its ends fixed to the base and handset. In both fixed and removable applications, the cover is held in place at the ends by string ties.

Applicant respectfully traverses the rejections under 35 U.S.C. 103(a). Applicant submits that a *prima facie* case of obviousness has not been established because Padilla and Ratzlaff are non-

analogous art, and the prior art does not provide the requisite motivation for modifying the pipe covers to suggest the modifications contemplated. See MPEP 2141.01 (a). To be analogous prior art, a reference must either be within n the inventor's field of endeavor or be in an art reasonable pertinent to the particular problem to be solved by the inventor. As set forth in *In re Antle*, 170
5 USPQ 285 (CCPA 1971), the CCPA stated the following" The very point in issue is whether one of ordinary skill in the art would have *selected*, without the advantage of hindsight and knowledge of the applicant's disclosure, the particular references which the examiner has applied. *Id.* at 287 [Emphasis in original].

It is Applicant's contention that without the advantage of hindsight and knowledge of her
10 disclosure, one of ordinary skill in the art would not have selected the references chosen by the Examiner. Applicant's further amendment of the claims clarify the distinction between the field of the invention and those of the references cited by the Examiner.

Applicant has amended Claims as indicated in the scanable copy of the claims below, and
15 acknowledges the withdrawal of claims 11 though 19 without traverse.

Applicant encloses below a clean set of all pending claims which incorporate the amendments made in this Amendment.